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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/625,052 | 07/24/2000 | Toshikazu Miyashita | 043034/0155 | 6637 |

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EXAMINER

YUN, EUGENE

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
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2683

DATE MAILED: 01/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/625,052

Applicant(s)

MIYASHITA, TOSHIKAZU

Examiner

Eugene Yun

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5-9 and 13-17 is/are rejected.
- 7) ☒ Claim(s) 2-4 and 10-12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 July 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1, 5, and 7 are rejected under 35 U.S.C. 102(e) as being anticipated by Bowers et al. (US 6,392,634).

Referring to Claim 1, Bowers teaches an input apparatus 30 (fig. 2) for inputting information to an information processing device 10 (fig. 1) provided with a display 24 (fig. 1), comprising:

a coupling mechanism 54 and 54a (fig. 2) for detachably coupling to a predetermined portion 58 (fig. 2) formed in the information processing device;

a coordinate information generator for generating coordinate information depending on a movement on a flat surface to control a position of a cursor on the display of the information processing device (see col. 5, lines 23-45); and

a cable for electrically connecting the input apparatus to the information processing device 66 (fig. 2).

Referring to Claim 5, Bowers also teaches the cable being allowed to be pulled out from a rewinding mechanism provided in the information processing device when the input apparatus is removed from the predetermined portion of the information processing device (see col. 4, lines 14-26).

Referring to Claim 7, Bowers also teaches at least two buttons which each functions as right-click and left-click buttons of a mouse when the input apparatus is separated from the predetermined portion of the information processing device 46 (fig. 2) and functions as right cursor key and left cursor key when the input apparatus is coupled to the predetermined portion of the information processing device by the coupling mechanism 50 (fig. 1).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 9 and 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bowers in view of Henderson (US 6,035,214).

Referring to Claim 9, Bowers teaches a portable apparatus comprising:

a display 24 (fig. 1);

an information processing device 10 (fig. 1);

an input device for inputting coordinate information to the information processing device to control a position of a cursor on the display, the coordinate information varying depending on a movement on a flat surface (see col. 5, lines 23-45); and

a coupling mechanism 54 and 54a (fig. 2) for detachably coupling the input device to a predetermined portion 58 (fig. 2) of the information processing device.

Bowers does not teach the portable apparatus being a portable telephone apparatus.

Henderson teaches the portable apparatus being a portable telephone apparatus (see ABSTRACT). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teachings of Henderson to said apparatus of Bowers in order to expand on the features of a portable telephone.

Referring to Claim 13, Bowers also teaches said coordinate information transferred from the input device to the information processing device through a cable 66 (fig. 2).

Referring to Claim 14, Bowers also teaches the coordinate information transferred from the input device to the information processing device by wireless (see fig. 6).

Referring to Claim 15, Bowers also teaches the information processing device controlling the input device so that it functions as a keypad of the portable telephone apparatus when the input device is coupled to the predetermined portion by the coupling mechanism (see 50 of fig. 1) and functions as a pointing device when the input device is not coupled to the predetermined portion (see fig. 2).

Referring to Claim 16, Bowers also teaches said input device as a pointing device (see Claim 3 of Bowers).

Referring to Claim 17, Bowers also teaches the pointing device as a mouse having at least a right-click key and a left-click key 46 (fig. 2).

6. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bowers in view of Ikehara et al. (US 6,400,353).

Bowers does not teach a connector connected to one end of the cable for detachably connecting to the information processing device through the cable. Ikehara teaches connector connected to one end of the cable for detachably connecting to the information processing device through the cable (see the end of cable 7 of fig. 1); and

a cable accommodating space formed in the input apparatus, for accommodating the cable with the connector therein 4 (fig. 1). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teachings of Ikehara to said apparatus of Bowers in order to expand on the features of a portable telephone.

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7. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bowers in view of Yeom et al. (US 5,943,625).

Bowers does not teach a keypad including a ten key pad. Yeom teaches a keypad including a ten key pad 24 (fig. 3). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teachings of Yeom to said apparatus of Bowers in order to expand on the features of a portable telephone.

Allowable Subject Matter

8. Claims 2-4 and 10-12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Regarding Claims 2 and 10, Bowers, Henderson, Ikehara, and Yeom do not teach, alone nor in combination, a battery accommodating portion for accommodating a battery which is used to supply power to the information processing device when the input device is coupled to the predetermined portion of the portable telephone apparatus by the coupling mechanism.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eugene Yun whose telephone number is (703) 305-2689. The examiner can normally be reached on 8:30am-5:30pm Alt. Fridays off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William G Trost can be reached on (703) 308-5318. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

Eugene Yun
Examiner
Art Unit 2683

EY
December 23, 2002



WILLIAM TROST
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